



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/806,036	07/05/2001	Mark Leslie Smythe	36677.29	3406
27683 7590 07/31/2008 HAYNES AND BOONE, LLP 901 Main Street Suite 3100 Dallas, TX 75202				
EXAMINER				
KAM, CHIH MIN				
ART UNIT		PAPER NUMBER		
1656				
MAIL DATE		DELIVERY MODE		
07/31/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/806,036

Applicant(s)

SMYTHE ET AL.

Examiner

CHIH-MIN KAM

Art Unit

1656

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-10, 12, 14-19, 32-35, 39, 40 and 44-53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 12, 32-35, 39, 40, 44, 45, 47, 49 and 51-53 is/are allowed.
- 6) ☒ Claim(s) 8-10, 14-19, 46, 48 and 50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of the Claims

1. Claims 8-10, 12, 14-19, 32-35, 39, 40 and 44-53 are pending.

Applicants' amendment filed on May 5, 2008 is acknowledged. Applicants' response has been fully considered. Claims 8, 12, 14, 19, 33, 44 and 46-49 have been amended, claims 11 and 13 have been cancelled, and a new claim 53 has been added. Thus, claims 8-10, 12, 14-19, 32-35, 39, 40 and 44-53 are examined.

Withdrawn Claim Rejections - 35 USC § 112

2. The previous rejection of claims 8-19, 33-35, 40, 44-50 and 52 under 35 U.S.C. 112, second paragraph, regarding A1 being a non-reversible N-substituent (paragraph 6 in the previous Office Action dated December 4, 2007), is withdrawn in view of applicant's amendment to the claims, applicants' cancellation of the claims, and applicant's response at pages 19-20 of the amendment filed May 5, 2008.

3. The previous rejection of claims 11-12 under 35 U.S.C. 112, second paragraph, (paragraph 7 in the previous Office Action dated December 4, 2007), is withdrawn in view of applicant's amendment to the claims, applicants' cancellation of the claims, and applicant's response at page 20 of the amendment filed May 5, 2008.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 8-10, 14-19, 46, 48 and 50 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. Claims 8-10, 14-19 and 50 are indefinite because the claim recites a method of synthesis of a cyclic peptide or peptidomimetic compound of General Formula I or General Formula II, however, the method steps of a)-d) only recite the preparation of peptides of general Formula I, but do not indicate how peptides of general Formula II having a cyclic peptide linked to a solid support are made. Thus, it is not clear how the final compounds of General Formula II are obtained. Claims 9-10, 14-19 and 50 are included in the rejection because they are dependent on rejected claims and do not correct the deficiency of the claim from which they depend.
6. Claim 46 is indefinite because the claim recites A2 is a ring contraction auxiliary compound indicated in the claim, however, A2 in claim 32 is defined as a covalently-bonded group of atoms comprising a reactive functionality to form an initial large cyclic peptide, thus A2 group is the group attached to the peptide, not the starting compound before reacting with the peptide. Claim 46 recites the limitation "said cyclic peptidomimetic" in the last line. There is insufficient antecedent basis for this limitation in the claim (claim 32). The same type of rejection is also applied to claim 48.

Response to Arguments

Applicants indicate claims 46 and 48 have been amended to recite A2 is a ring contraction auxiliary compound indicated in the claim, the rejection should be withdrawn (page 21 of the response).

Applicants' response has been considered, however, the arguments are not found persuasive because A2 is not a ring contraction auxiliary compound, but is generated from the reaction of a ring contraction auxiliary compound with the amino group on the peptide, please see claim 19. Thus, the rejection is maintained.

Conclusion

7. Claims 8-10, 14-19, 46, 48 and 50 are rejected. It appears claims 12, 32-35, 39, 40, 44, 45, 47, 49 and 51-53 are free of art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chih-Min Kam whose telephone number is (571) 272-0948. The examiner can normally be reached on 8.00-4:30, Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kathleen Bragdon can be reached at 571-272-0931. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Chih-Min Kam/

Primary Examiner, Art Unit 1656

CMK

July 29, 2008

